

RESPONSE

I. Restriction Requirement

The Examiner alleges that three distinct Restriction Requirements apply to the original claims. While in no way agreeing and solely to advance this application towards allowance, Applicants comply with these requirements. First the Examiner has determined that the original claims are directed to two separate and distinct inventions under 35 U.S.C. § 121, as follows:

Group I: Claims 1-4, allegedly drawn to an isolated nucleic acids and vectors, classified in class 536, subclass 23.1.

Group II: Claim 5, allegedly drawn to an isolated protein, classified in class 530, subclass 350.

In a second Restriction Requirement the Examiner alleges that the nucleic acid sequences of the original claims (SEQ ID NOS: 1- 35) are also directed to 18 separate and distinct inventions (Groups 1-18) under 35 U.S.C. § 121.

In a third Restriction Requirement the Examiner alleges that the amino acid sequences of the original claims (SEQ ID NOS: 2- 34) are also directed to 17 separate and distinct inventions (Groups 19-35) under 35 U.S.C. § 121.

II. Response to Restriction Requirement

In response to the Restriction Requirement mailed July 1, 2004 (Paper No. 09981318) and as instructed by the Examiner, Applicants make the following three elections with traverse. Applicants elect to prosecute the claims of Group I (Claims 1-4, allegedly drawn to an isolated nucleic acids and vectors, classified in class 536, subclass 23.1.). For the remaining two restrictions, Applicants further elect, pursuant to Requirement, Group 8 (SEQ ID NO:15) and Group 26 (SEQ ID NO:16). Applicants reserve the right to refile claims to the non-elected inventions in one or more future applications retaining the priority date of the present case and the earlier cited priority applications.

Applicants' traverse is respectfully based on the fact that the nucleic acid sequences

described in SEQ ID NOS: 1- 35 and the amino acid sequences SEQ ID NOS: 2- 34 are all encoded by a common genetic locus. It is Applicants' belief that the original Markush Claims 1-5 were proper. MPEP § 803.02 states:

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility.

All of the claims in the present invention read on splice variants of a novel human semaphorin protein. One of skill in the art would therefore agree that they share a common utility and, as splice variants, they share substantial structural features.

III. Status of the Claims

Claims 1-4 have been amended as a result of the present Restriction Requirement. Claim 5 has been cancelled, entirely without prejudice and without disclaimer, as being drawn to a non-elected invention. New claims 6-9 have been added to better and more clearly claim the present invention. As a result, claims 1-4 and 6-9 are therefore pending.

IV. Support for the Claims

Claims 1-4 have been amended to remove reference to non-elected inventions.

New Claim 6 has been added to more clearly claim aspects of the present invention. Claim 6 finds support throughout the specification, claims and sequence listing as originally filed, with particular support being found in original Claim 1 and on original SEQ ID NOS: 15 and 16.

New Claim 7 has been added to more clearly claim aspects of the present invention. Claim 7 finds support throughout the specification, claims and sequence listing as originally filed, with particular support being found in original Claim 4 on which it depends and on original SEQ ID NOS: 15.

New Claim 8 has been added to more clearly claim aspects of the present invention. Claim 8 finds support throughout the specification, claims and sequence listing as originally filed, with particular support being found in original Claim 4 on which it depends and at least at or about page 14 line 32 through page 15, line 5 of the specification as filed.

New Claim 9 has been added to more clearly claim certain aspects of the present invention. Claim 9 finds support throughout the specification, claims and sequence listing as originally filed, with particular support being found in Claim 8 (which in turn found particular support at least at or about page 14 line 32 through page 15, line 5 of the specification as filed) and on original SEQ ID NOS: 15.

As new claims 6-9 are fully supported by the specification, sequence listing and claims as originally filed, they do not constitute new matter. Entry is therefore respectfully requested.

V. Conclusion

The present document is a complete response to the Restriction and Species Election Requirement. Applicants believe that the claims of the instant application meet all of the conditions for patentability and are in condition for allowance. Accordingly, an early indication of the same is respectfully requested. Should Examiner Gucker have any questions or comments, or believe that certain amendments of the claims might serve to improve their clarity, a telephone call to the undersigned Applicants' representative is earnestly solicited.

Although Applicants believe that no additional fees are due in connection with this response, the Commissioner is authorized to charge any underpayment or credit any overpayment required with this response to Deposit Account No. 50-0892.

Respectfully submitted,

September 1, 2004

Date

 Peter G. Seaman
Reg. No. 41,866

Lance K. Ishimoto

Reg. No. 41,866

LEXICON GENETICS INCORPORATED

(281) 863-3333

Customer # 24231